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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/288,475	04/08/1999	JOEL ZDEPSKI	OPTVP002	7545

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EXAMINER

VAUGHN JR, WILLIAM C

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 03/26/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/288,475

Applicant(s)

ZDEPSKI, JOEL

Examiner

William C. Vaughn, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

1. This Action is in response to the Amendment and Reply received 31 December 2002.
2. Amendment B, Paper #11, received 31 December 2002 has been entered into record.

#### *Response to Arguments*

3. Applicant's arguments and amendments filed on 31 December 2002 have been carefully considered but they are not deemed fully persuasive. Applicant's arguments are deemed moot in view of the following new grounds of rejection as explained here below, necessitated by Applicant's substantial amendment to the claims which significantly affected the scope thereof.
4. The application has been examined. **Claims 20-40** are pending. The Examiner also acknowledges the cancellation of **claims 1-19**. The objections and rejections cited are as stated below:

#### *Claim Rejections - 35 USC § 112*

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 20, 21, 22, 38, 39 and 40** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 20, 38, 39 and 40, recites the limitation of "in response to determining said message does not correspond to said predetermined type, presenting said message as a normal e-mail message", is indefinite. What qualifies for a normal e-mail message. It is the Examiner's position that a predetermined type e-mail message qualifies as a normal e-mail message. The Examiner will interpret this limitation as a normal e-mail message as a predetermined type.

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8. Claim 22, recites the limitation of, "wherein if said message does correspond to said predetermined type, said received message includes programming code corresponding to said option, wherein said code includes a short option configured to describe said option in a brief manner" and "said code includes a long option configured to describe said option in an extended manner". These particular limitations are very unclear and indefinite. What does brief manner and extended manner comprise of in detail? Where within the specification is this taught? The Examiner will interpret the "brief manner" to mean the title of the message and the "extended manner" to mean the whole message received.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 20-24, 29, 31-34 and 37-39** are rejected under 35 U.S.C. 103(a) as being unpatentable over Noguchi et al. (Noguchi), U.S. Patent No. 6,163,345 in view of Cleron et al. (Cleron), U.S. Patent No. 6,223,213.

11. Regarding **claim 20**, Noguchi discloses the invention substantially as claimed. Noguchi discloses *a method for responding to an e-mail message comprising: receiving an e-mail message addressed to a user* [see Noguchi, Col. 8, lines 63-67 and Col. 9, lines 1-34]; *determining whether said message includes an indication that said message corresponds to a predetermined e-mail message type* [see Noguchi, Figure 12D, Col. 9, lines 1-34]. However, Noguchi does not explicitly disclose in response to determining said message does not

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correspond to said predetermined type, presenting said message as a normal e-mail message; in response to determining said message does correspond to said predetermined type: formatting and presenting said message according to a first format, wherein said first format includes a main message and at least one selectable option, said option being received in said received email message; presenting information related to the option in response to detecting said option is selected; and determining whether a reply message identifying the selected option is to be transmitted.

12. In the same field of endeavor, Cleron discloses (e.g., a browser based email system connected to a mail server). Cleron discloses *in response to determining said message does not correspond to said predetermined type, presenting said message as a normal e-mail message; in response to determining said message does correspond to said predetermined type: formatting and presenting said message according to a first format, wherein said first format includes a main message and at least one selectable option, said option being received in said received e-mail message; presenting information related to the option in response to detecting said option is selected; and determining whether a reply message identifying the selected option is to be transmitted* [see Cleron, Figures 9 and 10, Col. 3, lines 25-67, Col. 5, lines 15-67, Col. 6, lines 1-67 and Col. 7, lines 1-56].

13. Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Cleron's teachings of a browser based email system connected to a host server with the teachings of Noguchi, for the purpose of improving browser-based email systems for capturing audio and video clips within an email message utilizing a browser-based set-tip box (STB), [see Cleron, Col. 1, lines 10-67 and Col. 2,

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lines 52-56]. Therefore, it is for this reason, that Noguchi would have been motivated to further customize the messaging system of set top boxes. By this rationale **claim 20** is rejected.

14. Regarding **claim 21**, Noguchi-Cleron further discloses *wherein said predetermined type is an one-touch email type* [see Noguchi, Col. 9, lines 17-34]. By this rationale **claim 21** is rejected.

15. Regarding **claim 22**, Noguchi-Cleron further discloses *wherein if said message does correspond to said predetermined type, said received message includes programming code [inherent feature] corresponding to said option, wherein said code includes a short option configured to describe said option in a brief manner* (Noguchi teaches that the short message is the topic), [see Noguchi, Figure 12D], *and said code includes a long option configured to describe said option in an extended manner* [These feature are inherent]. By this rationale **claim 22** is rejected.

16. Regarding **claim 23**, Noguchi-Cleron further discloses *wherein the electronic message is received via an interactive television system* [see Noguchi, Col. 1, lines 63-67, Col. 2, lines 1-45]. By this rationale **claim 23** is rejected.

17. Regarding **claim 24**, Noguchi-Cleron further discloses *wherein the at least one option is selected by using a television remote control device* [see Noguchi, Figure 1, item 5]. By this rationale **claim 24** is rejected.

18. Regarding **claim 29**, Noguchi-Cleron further discloses *wherein the received message corresponds to an advertisement for a product or service, and wherein said reply message indicates an interest in the product or service by the user* [see Cleron, Col. 2, lines 52-53]. By this rationale **claim 29** is rejected.

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19. Regarding **claim 31**, Noguchi-Cleron further discloses *a method for sending an e-mail message* [see rejection of claim 20, supra] *comprising: creating an e-mail message, said message including: an indication said e-mail message corresponds to a predetermined e-mail message type of a plurality of e-mail message types* [see rejection of claim 20, supra]; *a main message; at least one selectable option; information related to the option, wherein the information is to be presented after the option has been presented and selected; and transmitting the e-mail message* [see rejection of claim 20, supra]. By this rationale **claim 31** is rejected.

20. Regarding **claim 32**, Noguchi-Cleron further discloses *wherein the predetermined type is an one-touch email type* [see rejection of claim 21, supra]. By this rationale **claim 32** is rejected.

21. Regarding **claim 33**, Noguchi-Cleron further discloses *wherein the electronic message is transmitted via an interactive television system* [see rejection of claim 23, supra]. By this rationale **claim 33** is rejected.

22. Regarding **claim 34**, Noguchi-Cleron further discloses *wherein, the at least one option is to be selected by using a television remote control device* [see Noguchi, Figure 1, item 5]. By this rationale **claim 34** is rejected.

23. Regarding **claim 37**, Noguchi-Cleron further discloses *wherein the main message corresponds to an advertisement for a product or service, and wherein said option is selectable by a user to indicate an interest in said product or service* [see rejection of claim 29, supra]. By this rationale **claim 37** is rejected.

24. **Claim 38**, list all the same elements of **claims 1 and 31**, but in system form rather than method form. Therefore, the supporting rationale of the rejection to **claims 1 and 31** applies equally as well to **claim 38**.

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25. **Claim 39**, list all the same elements of **claims 1 and 31**, but in apparatus form rather than method form. Therefore, the supporting rationale of the rejection to **claims 1 and 31** applies equally as well to **claim 39**.

***Claim Rejections - 35 USC § 103***

26. **Claims 25, 26, 30, 35, 36 and 40** are rejected under 35 U.S.C. 103(a) as being unpatentable over Noguchi-Cleron and in further view of well known in the art.

27. Regarding **claim 25**, Noguchi discloses the invention substantially as claimed. However, Noguchi does not explicitly disclose wherein in response to determining said reply message is to be transmitted, the reply message is automatically generated and sent responsive to a single indication received from a viewer ((The inclusion of automatically generated a reply message and sent responsive to a single indication received from a viewer would have been obvious to one of ordinary skill in the networking art at the time the invention was made in view of the notoriously widely known and widely implementation of these features in the networking art. The Examiner takes **Official Notice** (MPEP 2144.03) that “wherein in response to determining said reply message is to be transmitted, the reply message is automatically generated and sent responsive to a single indication received from a viewer in the email environment is well known in the networking art at the time the invention was made as exemplified by the notoriously well known application Microsoft Office as well as other well known email application relevant to this application. The Applicant is entitled to traverse the official notice according to MPEP 2144.03. However, MPEP 2144.03 further states, “See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate



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information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice).” Specifically, In re Boon, 169 USPQ 231, 234 states “as we held in Ahlert, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed”. Further 37 CFR 1.671©(3) states “Judicial notice means official notice”. Thus, a traversal by the Applicant that is merely “a bald challenge, with nothing more” will be given little weight). By this rationale **claim 25** is rejected.

28. Regarding **claim 26**, Noguchi-Cleron and well known discloses *wherein the reply message is sent to the original sender of the received electronic message* [see rejection of claim 25, supra]. By this rationale **claim 26** is rejected.

29. Regarding **claim 27**, Noguchi-Cleron and well known does not explicitly disclose further *comprising determining whether a second option has been selected if it is determined that the reply message identifying the selected option is not to be transmitted* (However, such limitations are a matter of design choice (see MPEP 716.02(f)) and would have been obvious to the system of Noguchi-Cleron. Since, Cleron does specifically teach the option of sending a reply to the email. The limitations of claim 27 do not define a patentable distinct invention over that defined in the combined teachings of Noguchi-Cleron-well known in the art. By this rationale **claim 27** is rejected.

30. Regarding **claim 28**, Noguchi-Cleron and well known discloses *wherein the second option is selected by selecting a key on a remote control device, wherein the key corresponds to the second option* [see Noguchi, Figure 1, item 5]. By this rationale **claim 28** is rejected.

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31. Regarding **claim 30**, Noguchi-Cleron and well known discloses *wherein the selected option is identified in a header of the reply message* (The Examiner takes Official Notice (MPEP 2144.03) that this feature is extremely well known in the art for an email message reply to include a header). By this rationale **claim 30** is rejected.

32. Regarding **claim 35**, Noguchi-Cleron and well known discloses *wherein the at least one option is to be identified in an automatically generated reply message if the at least one option is selected* [see rejection of claim 25, supra]. By this rationale **claim 35** is rejected.

33. Regarding **claim 36**, Noguchi-Cleron and well known discloses *wherein the selected option is identified in a header of the reply message if the selected option is to be transmitted* [see rejection of claim 30, supra]. By this rationale **claim 36** is rejected.

34. Regarding **claim 40**, *wherein the computer readable medium is selected from the group consisting of CD-ROM* (The Examiner takes Official Notice (MPEP 2144.03), *floppy disk, tape, flash memory, system memory* (see Noguchi, Col. 4, lines 49-50], *hard drive, and data signal embodied in a carrier wave* [This feature is inherent within any electromagnetic wave that can be modulated, as in the frequency, amplitude, or phase, in order to transmit speech, music, images, or other signals]. By this rationale **claim 40** is rejected.

### ***Response to Arguments***

35. Again, it is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art. As it is Applicant's right to continue to claim as

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broadly as possible their invention. It is also the Examiner's right to continue to interpret the claim language as broadly as possible. It is the Examiner's position that the detailed functionality that allows for Applicant's invention to overcome the prior art used in the rejection, fails to differentiate in detail how these features are unique. As it is extremely well known in the networking art as already shown by Noguchi-Cleron as well as other prior art of record. For an email browser system within a webTV or set top box (STB) environment to have reply options that include headers and automatic reply or do not send options. Thus, it is clear that Applicant must submit amendments to the claims in order to distinguish over the prior art use in the rejection that discloses different features of Applicant's claim invention. It is the Examiner's position that the Applicant has not provided in anyway the differences between what is well known in the art (i.e., email headers, that include menu options and a main message as well as an option to reply) and their claimed invention.

36. Applicant employs broad language, which includes the use of word, and phrases, which have broad meanings in the art. In addition, Applicant has not argued any narrower interpretation of the claim language, nor amended the claims significantly enough to construe a narrower meaning to the limitations. As the claims breadth allows multiple interpretations and meanings, which are broader than Applicant's disclosure, the Examiner is forced to interpret the claim limitations as broadly and as reasonably possible, in determining patentability of the disclosed invention. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.1993).

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37. Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response, and reiterates the need for the Applicant to more clearly and distinctly, define the claimed invention.

### *Conclusion*

38. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Vaughn, Jr. whose telephone number is (703) 306-9129. The examiner can normally be reached on 8:00-5:00, 1st Friday Off.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Powell can be reached on (703) 305-9703. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9700.



**WCV**  
**Patent Examiner**  
**Art Unit 2142**  
**March 20, 2003**



**MARK R. POWELL**  
**SUPERVISORY PATENT EXAMINER**  
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